



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of: ADAMS *et al.*

RECEIVED

Application No.: 09/817,278

Group Art Unit: 3743

JUN 03 2003

Filed: March 27, 2001

Examiner: Ferko, K. TECHNOLOGY CENTER R3700

For: MULTI-MODE LIGHTER

Attorney Docket No.: 618-979

REPLY BRIEF IN RESPONSE TO EXAMINER'S ANSWER

MS Appeal Brief - Patents

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Examiner's Answer dated March 25, 2003, please enter and consider the following Reply submitted in accordance with 37 CFR § 1.193(b).

RESPONSE TO EXAMINER'S ARGUMENTS

The following remarks address the arguments presented in Section 11 of the Examiner's Answer.

A. Independent Claim 1

Independent claim 1 requires, in part, a moveable wand assembly "capable of causing the actuating member to be immobilized sufficiently to prevent ignition of the fuel." As described in section A.2 of applicant's Appeal Brief, the plain meaning of the term "immobilized" is to render immobile or fixed. The plain meaning of the term "immobile" is immovable or fixed. Claim 1 was rejected as anticipated by U.S. Patent No. 5,199,865 to Liang ("Liang").

The Examiner's reply provides two bases to support the proposition that the rotating nozzle of Liang is "capable of causing the actuating member to be immobilized sufficiently to prevent ignition of the fuel," as required by claim 1. (Examiner's Reply, March 25, 2003; pp.3-6). The first basis advanced by the Examiner is that the wand assembly of Liang obstructs access to the actuator such that the actuating member is immobile/not moving in "a manner sufficient to prevent actuation." (*Id.*, 4:14-16). This rationale confuses the operation of the lighter of Liang with the state of the recited elements of claim 1, since preventing access to the actuator of Liang does not effect the ability or

inherent capacity of the actuator to move and ignite the lighter. This distinction may be illustrated, for instance, by the difference between an object that is not moving and an object which is immovable. Clearly, an object that is not moving is not necessarily immovable. Thus, the Examiner has failed to provide a rationale or evidence tending to show inherency¹. The second basis advanced by the Examiner proves this point. The Examiner stated, "if the lock [of Liang] is used and the wand [of Liang] is closed, it is not possible to actuate the lighter. (*Id.*, 5:3-5). Thus, the Examiner acknowledges that it is the lock and not the rotating nozzle of Liang that is capable of causing the actuating member to be immobilized sufficiently to prevent ignition of the fuel.

Claim 1 and its dependents require the movable wand assembly to be capable of causing the actuating member to be immobilized sufficiently to prevent ignition of the fuel. The Examiner neglects the definition of immobilize which means to render immobile, that is render immovable, fixed. In the claimed invention, the wand assembly renders the actuating member immobile. In Liang, the wand assembly does not render the actuating member immovable, at best, it only blocks access to the actuating member. The rotating nozzle of Liang, therefore, is simply not "capable of causing the actuating member to be immobilized sufficiently to prevent ignition of the fuel," as required by claim 1. (*See also* section A.1 of Appeal Brief). Hence, Liang does not have each and every element of claim 1, and the rejection of claim 1 as anticipated by Liang should be withdrawn.²

B. Dependent claims 2-21

The Examiner's reply did not address the limitations of dependent claims 2-21. As described in section A.4 of applicants Appeal Brief, claims 2-21 define more particular aspects of Applicants' invention in addition to the features and elements of independent claim 1. More specifically, on page 6 of applicant's Appeal Brief, applicants identified claims 7-8 as requiring an actuating member which is "slidable" which is not disclosed, suggested, or taught by Liang; and claims 9-16 and 19 as requiring a "cam follower operatively associated

¹ "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (Emphasis in original)." (MPEP, p. 2100-52).

² Applicants note the Examiner's statement: "It appears that appellant is attempting to craft claim language that is broader in scope than the best mode disclosed in the specification." (Examiner's Reply, March 25, 2003; 5:13-15). This statement is irrelevant to examination of claim 1 under 35 U.S.C. § 102, and provides further evidence that the bases and rationale for the Examiner's rejection of claim 1, to limit applicant to the preferred embodiment, are improper and should be reversed.

with the housing and including a first portion for interacting with the wand assembly and a second portion for interacting with the actuating member," which is not disclosed, suggested or taught by Liang.

C. Independent claim 68

Independent claim 68 requires, in part, a conduit for transporting fuel from the supply to the nozzle, wherein the conduit contains a lead from the ignition assembly for igniting fuel at the nozzle. Claim 68 was rejected as anticipated by U.S. Patent No. 6,213,759 B1 to Sung ("Sung"). The Examiner asserts that tube 28 of Sung is a "conduit" as recited by claim 68. (*Id.*, 6:12). It is the Examiner's position that tube 28 "contains the supply of fuel, element 26, and the lead from the ignition assembly." (*Id.*, 6:12-13). These propositions are simply inaccurate and incorrect. As an initial matter, tube 28 does not contain "the supply of fuel, element 26," as stated by the Examiner. As described in Sung, "[f]luid is released to nozzle tip 16 by trigger 18, engaging lever 34 to open valve 36, allowing fluid to flow from fluid reservoir 26 through tube 28 to nozzle tip 16." (Sung, 5:12-14). Thus, fluid reservoir 26 and valve 36 contain the fuel supply of Sung. Tube 28, by contrast, conveys fuel from the fluid reservoir to the nozzle. (*Id.*, 5:8-11). Moreover, as described in section B.1 of applicant's Appeal Brief, Sung discloses an electrical circuit for igniting fuel at the nozzle that is not contained in tube 28. As tube 28 does not contain "a lead from the ignition assembly for igniting fuel at the nozzle," Sung does not have each and every element of claim 68. Hence, the rejection of claim 68 as anticipated by Sung is improper and should be reversed.³

D. Dependent claims 69-77

The Examiner's reply did not address the limitations of dependent claims 69-77. As described in section B.2 of applicants Appeal Brief, claims 69-77 define more particular aspects of Applicants' invention in addition to the features and elements of independent claim 68. Specifically, applicants argued independent bases for claims 72-73 and 75-76 which were not addressed by the Examiner.

³ The Examiner further stated: "The fuel and the lead are contained within the conduit and the language of claim 68 does not preclude that from transporting an additional fuel line or a conduit within a conduit, as in the invention of Sung." (Examiner's Reply, March 25, 2003; 6:15-18). Applicants, agree that claim 68 does not preclude the conduit from having additional fuel lines or conduits therein. However, as described above with regard to Sung, tube 28 does not contain a lead from the ignition assembly as required by claim 68. Sung also fails to disclose, teach, or suggest additional fuel lines or other conduits within tube 28.

CONCLUSION

For the foregoing reasons, Applicants respectfully maintain that the final rejections of claims 1-21 and 68-77 are in error and should be reversed. No fees are believed due for this submission. Should any fees be required, however, please charge all required fees under 37 C.F.R. 1.17 to Pennie & Edmonds Deposit Account No. 16-1150.

Respectfully submitted,



Date May 27, 2003

cc: Brian M. Rothery

Arthur M. Antonelli Reg. No. 51,410
For: Brian M. Rothery Reg. No. 35,340

PENNIE & EDMONDS LLP
1667 K Street, N.W.
Washington, DC 20006
(202) 496-4400